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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,378	02/17/2004	Jeff Blaylock	ZIM0356	1826
7590 12/12/2007				
John F. Hoffman, Esq. BAKER & DANIELS LLP Suite 800 111 East Wayne Street Fort Wayne, IN 46802				
		EXAMINER PREBILIC, PAUL B		
		ART UNIT PAPER NUMBER 3774		
		MAIL DATE DELIVERY MODE 12/12/2007 PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/780,378	<b>Applicant(s)</b> BLAYLOCK ET AL.	
	<b>Examiner</b> Paul B. Prebilic	<b>Art Unit</b> 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 56-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Upon review of the specification, original support could not be found for a passageway sized to allow movement in medial-lateral and anterior-posterior directions; see page 9, line 19 to page 10, line 8. In fact, the only mention of mounting the base plate and stem to the augment involved cementing the augment to the stem; see Figure 8 and page 15, line 17 to page 16, line 2. For this reason, the presently claimed subject matter lacks original support.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The terminology "ring-shaped" lacks antecedent basis from the specification.

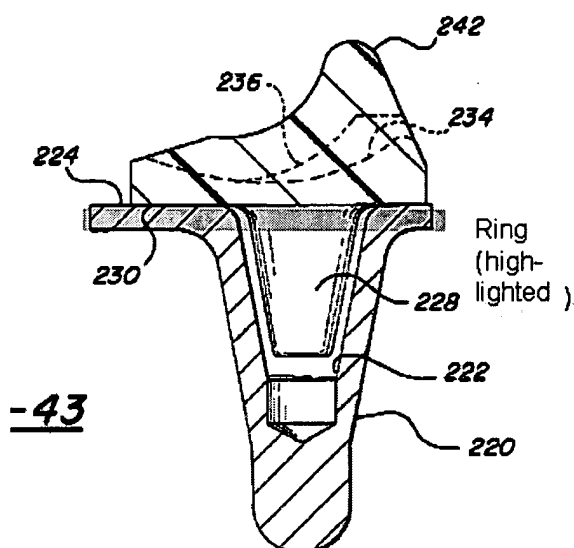
***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56, 58-60, and 62-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Pottenger et al (US 6,039,764). Pottenger anticipates the claim language where the tibial implant as claimed corresponds to the bearing element (226) of Pottenger, the tibial augment as claimed corresponds to the tibial component (218), the ring-shaped annular body as claimed corresponds to the highlighted portion of the tibial component that surrounds the recess (222) (see illustration below); and the passageway as claimed is the recess (222); see Figure 43 and column 23, lines 21-39.



With regard to claim 62, the claim language is met where the heights can be measured along the angled portions and compared to the heights of the vertical portions.

With regard to claim 64, the exterior wall as claimed is the underside of the plate of Pottenger.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pottenger et al (US 6,039,764) in view of Johnson et al (US 6,136,029). Pottenger meets the claim language as explained in the Section 102 rejection *supra* but fails to disclose the utilization of porous tantalum as the implant material. However, Johnson

teaches that it was known to use porous tantalum in the art; see column 4, lines 42-58.

Therefore, it is the Examiner's position that it would have been obvious to utilize porous tantalum as the implant material for the same reasons that Johnson utilizes the same.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pottenger et al (US 6,039,764) in view of Bolesky (US 4,822,366). Pottenger meets the claim language as explained in the Section 102 rejection *supra* but Pottenger fails to disclose utilizing a plurality of tibial augments of different size as claimed. However, Bolesky teaches utilization of a plurality of differently-sized augments was known to the art; see Figures 2 and 6 as well as column 6, lines 35-54. Therefore, it is the Examiner's position that it would have been considered *prima facie* obvious to an ordinary artisan to provide a plurality of different-sized augments so as make the invention adaptable to a plurality of different-sized patients.

### ***Response to Arguments***

Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive.

In response to the traversal of the Section 112 rejection, the Examiner asserts that a different embodiment or invention is disclosed in the incorporated application. Furthermore, the incorporation is not specific to the present application and does not refer to it; see MPEP 608.01(p) that is incorporated herein by reference. In other words, the incorporation does not state that the augments of the incorporated application can be used in the present application and that the augments are designed to fit with the stem as argued and claimed. Moreover, the Figure 1 to 4 embodiment of the

incorporated application only shows that the medial-lateral direction has a spacing between the stem and augment. It is not clear that such a space would exist in the anterior-posterior direction. For these reasons, the rejection has been maintained.

With regard to the prior art rejections, the Examiner has modified the interpretation of Pottenger to explain how the present claims can still be read on thereby.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774